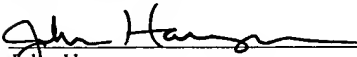


Docket No: 22562-7

**CERTIFICATE OF MAILING**

I hereby certify that this paper is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment; Commissioner for Patents; P.O. Box 1450; Alexandria, VA 22313-1450 on November 8, 2005

  
John Harmeyer



*IFW*  
**PATENT**

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

Applicant: Kozo Saito et al. : Paper No:  
Serial No.: 10/629,426 : Group Art Unit: 2878  
Filed: July 29, 2003 : Examiner: Albert J. Gagliardi  
For: **Systems and Methods for**  
**Inspecting Coatings** :

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Transmitted herewith is a Response to Restriction and Election Requirements in the above-identified application.

- ☐ additional fee is required.  
☒ also attached: Request for One Month Extension; Return Postcard

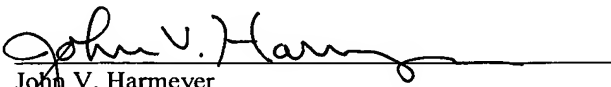
The fee has been calculated as shown below:

	NO. OF CLAIMS	HIGHEST PREVIOUS PAID FOR	EXTRA CLAIMS	RATE	FEE
Total Claims	30	30	0	x \$50 =	\$0
Independent Claims	5	5	0	x \$200 =	\$0
If multiple claims newly presented, add \$290.00					-----
1 Month Extension Fee					\$120
Information Disclosure Statement					\$000.00
<b>TOTAL FEE DUE</b>					<b>\$120</b>

- ☐ Please charge my Deposit Account No. 04-1133 in the amount of \$.
- ☒ Please charge the amount of \$120 to our Visa credit card. Form PTO-2038 is enclosed.

[x] The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment, to Deposit Account No. 04-1133, including any filing fees under 37 CFR 1.16 for presentation of extra claims and any patent application processing fees under 37 CFR 1.17.

Respectfully submitted,

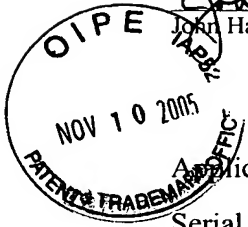
By:   
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Docket No.: 22562-7

**Patent**

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*John Harmeyer*  
John Harmeyer

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

Applicant: Kozo Saito et al.

Paper No.:

Serial No.: 10/629,426

Group Art Unit: 2878

Filed: July 29, 2003

Examiner: Albert J. Gagliardi

For: **SYSTEMS AND METHODS FOR INSPECTING COATINGS**

**RESPONSE TO RESTRICTION AND ELECTION REQUIREMENTS**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Please consider the following remarks in response to the restriction and election requirements set forth in the Official Action dated September 8, 2005.

**Restriction Requirement**

In the Official Action dated September 8, 2005, the Examiner required restriction under 35 USC 121 to one of the following groups specified in the Office Action:

- I. Claims 1-8; and
- II. Claims 9-30.

Applicants respectfully traverse the requirement on the basis that the groupings are related such that the same art classifications would need to be searched for one grouping as

for the other, and the same general field of search would be required. See MPEP § 808.02. In particular, the groupings are related as all referring to a system or method for detecting defects in coatings in the claim or preamble, and have elements in common regardless of additional patentable distinctions or the ability to be separately usable. Accordingly, the same general field of search would apply to the groupings, and the same classes/subclasses indicated would need to be searched as they may have art pertinent to the other. For example, the classification indicated for Group I (Class 250, subclass 339.14- Detecting infrared emissive objects) is related to the claims of Group II (Class 250, subclass 341.6 (Heating of object or material)). Accordingly, even if an apparatus claimed can be used in a different process or the process can be practiced by another apparatus, the requirements of MPEP § 808.02 need to be met as well, and Applicants believe that they are not present in this case. In particular, there need not have been a separate sub-classification (808.02(A)), and Applicants believe that no separate status in the art has been shown (808.02(B)) and that the same field of search applies to both (808.02(C)). (See also MPEP § 904.02(a), stating "In outlining a field of search, the examiner should note every class and subclass under the U.S. Patent Classification system and other organized systems of literature that may have material pertinent to the subject matter as claimed.")

Moreover, Applicants respectfully submit that Applicants would be faced with an undue burden and expense if forced to file multiple divisional patent applications on the related groupings set forth in the Office Action, and that it would not be unduly burdensome to simultaneously examine all of the claims in this application.

Furthermore, the statutory mandate of 35 U.S.C. §121 requiring a finding of two or more independent and distinct inventions has not been shown in this case. In particular, 35 U.S.C. §121 states that "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the

inventions.” Consequently, the standard for restriction requirements is that two or more independent and distinct inventions must be present. In imposing the present requirement, the Office Action focuses only on distinctness. It is Applicant’s position that absent a showing of independence, imposition of the present restriction requirement fails to comply with the requirements of 35 U.S.C. §121. Moreover, even when two or more independent and distinct inventions are found, imposition of the requirement is discretionary with the Commissioner.

Accordingly, reconsideration of the restriction requirement is requested.

For purposes of complying with 37 C.F.R. § 1.143, Applicants hereby provisionally elect with traverse the group labeled in the Office Action as Group II, claims 9-30.

#### *Election Requirement*

In the Official Action, the Examiner further required Applicants under 35 U.S.C. §121 to elect a single disclosed species for prosecution on the merits to which the claims should be restricted if no generic claim is finally held to be allowable. Applicants further believe that this election requirement is improper. Pursuant to MPEP § 808.02 and § 803, a requirement for restriction would only be permissible if there is a patentable difference between the species as claimed and there would be a serious burden on the examiner if restriction is not required. This requirement is made with respect to restrictions generally, and restrictions includes those involving species. (See MPEP 802.02, defining restrictions to include species type restrictions). Accordingly, per MPEP 808.02, the Office Action must explain why there would be a serious burden on the examiner if restriction is not required, and the Office Action must show by appropriate explanation one of the following: separate classification, separate status in the art, or different field of search. With respect to the election requirement in the

Office Action regarding Species 1-5, no such explanation has been provided. Even though such an explanation has been provided with respect to the restriction requirement between Groups I and II, no such explanation has been provided in the Office Action with respect to the later restriction requirement among Species 1-5.

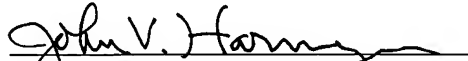
Moreover, Applicants submit that it would not be unduly burdensome for the Examiner to search the invention without an election of species. This is particularly true with respect to Species 2-5, which all fall under claims 9-30, which have all already been identified in the Office Action as being in the same classification. In particular, the Office Action already indicates that claims 9-30 are collectively drawn "to methods of determining defects in coatings," all classified in class 250, subclass 341.6. Of the five species later identified in the Office Action, Species 2-5 fall within claims 9-30 as indicated in the Office Action. Applicants submit that, an undue burden has not been explained in the Office Action as required by MPEP 808.02 with respect to the identified species, and that such a burden especially cannot be established with respect to the Species 2-5 falling within claims 9-30, as these claims already been identified in the Office Action as falling in the same classification. Therefore, it is believed that separate classification, separate status in the art, or different field of search cannot be shown with respect to Species 2-5, which all fall under the same classification, and it is therefore requested that at least these claims be examined together.

Moreover, the Office Action is essentially requiring through the restriction/election requirement that the Applicants file five applications. Such would be extremely expensive and burdensome on the Applicants. Accordingly, reconsideration and withdrawal of the election of species requirement is respectfully requested.

Applicants hereby provisionally elect the species identified as Species 3 with traverse. It is believed that at least claims 15-19 read on the elected species as indicated in the Office Action. This election of species is made without admission and with traverse.

It is believed that the above represents a complete response to the restriction and election requirements. Reconsideration and further examination on the merits are respectfully requested.

Respectfully submitted,



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